

# Notice of Allowability

Application No.

10/798,198

Examiner

Zachary C. Tucker

Applicant(s)

MUNCHHOF, MICHAEL J.

Art Unit

1624

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 1 November 2006.
2. ☒ The allowed claim(s) is/are 1-12 and 15-20.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

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**EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone conversation between the examiner and applicant's counsel, Roseanne Goodman, on 20 November 2006.

**IN THE CLAIMS –**

In line 9 of claim 8, the phrase **–(C<sub>1</sub>-C<sub>8</sub>)alcohol–** has been replaced with **(C<sub>1</sub>-C<sub>8</sub>)hydroxyalkyl**.

**Claims 13 and 14 have been cancelled.**

**end of amendments**

***Response to Amendment***

As requested in applicant's correspondence, filed 1 November 2006 (hereinafter "present amendment"), in response to the Non-Final Office action mailed 15 August 2006 (hereinafter "previous Office action"), claims 1, 5, 8, 15, 17 and 20 have been amended. The specification at pages 1, 2, 6 and 15 has been amended as requested as well.

***Election/Restrictions***

In view of the present amendment, which overcomes all rejections set forth in the previous Office action, claims 5-11 are hereby rejoined. Those claims (5-11) were withdrawn for the reason that they did not read on the elected species. When an election of species requirement is operative, and claims which read on the elected species are anticipated by the prior art (in the previous Office action, claims 1-4 and 20 were rejected under 35 U.S.C. 102 as being anticipated by the prior art), claims which do not read on the elected species are withdrawn from consideration. Upon amendment of the claims so as to overcome the prior art-based rejections, the search of the claims is broadened and continued. The search of the present claims was broadened in view of the present amendment, and no prior art anticipating any of the claims was found, whereupon those claims withdrawn for the reason that they do not read on the elected species were rejoined, pursuant to "Markush Practice" outlined in MPEP 803.02.

Claims 12-14, which were withdrawn from consideration under 37 C.F.R. 1.142(b), as not being drawn to an elected invention. In view of the present amendment, which places the claims of the elected Group in condition for allowance, withdrawn claims that include all of the limitations of the claims of the elected Group are properly rejoined.

Claims 13 and 14, however, have been cancelled with the authorization of applicant's counsel.

***Status of Claim Rejections - 35 USC § 102***

In the previous Office action, claims 1-4 and 20 were rejected under (a) and (e) of this statute as being anticipated by WO 03/004475 (Berg et al). Compounds disclosed in the Berg et al publication are not embraced by the instant claims because the R<sup>2</sup> group must be bonded to the carbonyl group at the 3-position on the pyrazine ring *through* a nitrogen atom. The compounds disclosed by Berg et al which were cited in the rejection (structures shown on page 7 of the previous Office action) although they contain a nitrogen atom *in the ring* bonded to the 3-carbonyl group on the central pyrazine ring, are not bonded to that carbonyl group *through* a nitrogen atom.

***Abstract of the Disclosure***

In the previous Office action, objection to the abstract was re-stated, but applicant again has not replied to that objection. The objection is hereby withdrawn so as to allow the instant application to be passed to issue; it is not an actual requirement that applicants include a generic structure in the abstract, although in the examiner's opinion it makes for a *better* description of the invention disclosed when said invention is a family of chemical compounds as is the present invention. Applicant's failure to reply to the objection has not been held as sufficient to hold the present amendment as nonresponsive because it appears that a good faith effort was undertaken to reply to the examiner's previous Office action.

Applicant has chosen to leave the abstract in the form as originally filed.

***Allowable Subject Matter***

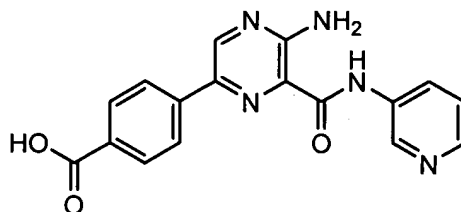
Claims 1-12 and 15-20 are allowed.

All previously stated objections and rejections have been withdrawn. Close prior art with respect to the compounds embraced by the allowed claims includes the De Meester et al reference which was relied upon in rejections under 35 U.S.C. 102 in the first non-final Office action mailed on 12 April 2006. The compounds described and reported by De Meester et al are no longer embraced by the instant claims because of the narrowing of the definition of the alkyl or hydroxyalkyl groups within the definition of variable R<sup>2</sup>.

Also of note and representative of the closest prior art is the Bakthavatchalam et al publication which was relied upon in a rejection under 35 U.S.C. 102 in the first non-final Office action mailed on 12 April 2006. The Bakthavatchalam et al publication discloses an intermediate compound, employed in the synthesis of imidazo[4,5-b]pyrazine compounds, which is like those according to the instant claims. At the position on that intermediate compound (whose structure is represented on page of that Office action) which corresponds to R<sup>2</sup> in the compounds according to the present invention, an amino group (-NH<sub>2</sub>) is present.

Finally, the Berg et al publication, cited in a rejection under 35 U.S.C. 102(a) and (e) in the previous Office action, constitutes particularly close prior art. Example 35 in that publication (page 37) describes the synthesis of the compound 4-{5-amino-6-[(pyridin-3-ylamino)carbonyl]pyrazin-2-yl}benzoic acid, which has the structure according to the following diagram (next page):

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This compound, although the pyridin-3-yl substituent is bonded to the 3-carbonyl group on the central pyrazine ring through a nitrogen atom, is not embraced by any of the instant claims because where the phenyl group is permitted to be substituted with a carboxyl group (-C(O)-OH), the R<sup>2</sup> is not permitted to be heteroaryl (see allowed claim 20), and *vice-versa* (see allowed claims 1 and 8).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### Conclusion

All Post-Allowance Correspondence concerning this application must be mailed to:  
Mail Stop Issue Fee  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or you can fax them to the Office of Patent Publications at 703-872-9306, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312; information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027. The Notice of Allowance also has an insert containing contact information on other items, including Issue Fees, receipt of formal drawings and the status of the application.

Zachary C. Tucker  
Primary Examiner  
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